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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,434	12/19/2001	Yoshiaki Yokoo	159-69	2082

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EXAMINER	
WEIER, ANTHONY J	

ART UNIT	PAPER NUMBER
1761	

DATE MAILED: 05/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/021,434	YOKOO ET AL.	
	Examiner	Art Unit	
	Anthony Weier	1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 March 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *18-54* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *18-54* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 37 and 54 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, the original specification does not provide support for the specific definition of "lightly sweetened" being " a saccharide in an amount no greater than 2.5 wt% as a sweet component." Although it is noted that Applicant provides a translated sheet of Japanese labeling standards, it is not seen how this relates to the terminology "lightly sweetened" as a common definition for this particular term. What is "lightly sweetened" to one person may be something else to another.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 18-24, 27-30, and 33-36 are rejected under 35 USC 102(b) as being anticipated by Sasagawa et al.

The claims stand rejected for the reasons set forth in the last Office Action.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the

invention was made.

4. Claims 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasagawa et al.

The claims stand rejected for the reasons set forth in the last Office Action and in view of the following. As for the recitation that milk added coffee beverage contain a certain amount of sweetener (e.g. less than 2.5 wt% saccharide), such determination would have been well within the purview of one skilled in the art, and it would have been further obvious to have arrived at such amount as a matter of preference depending upon the particular amount of sweetness desired in the product or for reasons of health regarding the amount of sugar in the product.

5. Claims 38-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 11-9190 taken together with Kawai et al.

JP 11-9190 discloses a product containing an amino acid added coffee component with a cow milk component added therein and wherein the product has been heat sterilized (see Abstract). It should be further noted that JP 11-9190 discloses said composition having a pH within the range claims (e.g. pH 6.9; see Example 1), the amount of milk called for (e.g. approximately 5% in Example 1), and the amount of amino acid called for (approximately 0.12%; see Example 1; 1.22 g out of a total of 1000 g). It is expected that the amount of sodium bicarbonate added would be less than 0.14 % as it is such a low amount it is not included in the composition breakdown of the product in Example 1 of JP 11-9190. In addition, JP 11-9190 discloses packaging said milk in a hermetically sealed container (e.g. retort can), and it is expected that same would then be capable of marketing.

The claims differ in that JP 11-9190 is silent regarding the use of a basic amino acid (lysine, arginine or histidine). However, it is known to employ arginine, a basic amino acid, in coffee preparations (which also contain a milk component) to improve the flavor of the coffee as taught, for example, by Kawai et al (e.g. Abstract; Examples). It would have been obvious to one having ordinary skill in the art at the time of the invention to have included arginine as the amino acid in JP 11-9190 for the flavor improvement recited in Kawai et al.

It is expected that the addition the basic amino acid in the modified JP 11-9190 product would reduce the amount of emulsifier and/or thickening agent required. In addition, JP 11-9190 discloses the use of an emulsifier in the composition which occupies well below 1% of the product (0.3 g sucrose fatty acid ester in a 52 g coffee extract composition which further includes milk and other ingredients; see translation).

Although Example 1 of JP 11-9190 discloses the use of approximately 12% milk, JP 11-9190 does not limit the milk to any particular amount. It would have been well

within the purview of one skilled in the art to determined such amount, and it would have been obvious to have arrived at such amount as a result effective variable depending on, for example, the degree of dairy flavor desired in the final product.

JP 11-9190 further discloses said composition being lightly sweetened (e.g. 0.06% cane sugar).

Response to Arguments

6. Applicant's arguments filed 3/20/06 have been fully considered but they are not persuasive.

Applicant argues that Sasagawa et al employs potassium hydroxide to generic beverages. However, it should be noted that Sasagawa et al discloses the use of same in conjunction with beverages of the instant invention which would include coffee (e.g. Example 1). The effects expected from Sasagawa et al are those contained therein expressly. However, due to the similarity of processing and the amounts of potassium hydroxide between the instant invention as claimed and that of Sasagawa et al it is further expected that the attributes of the instant invention would also be attained. Applicant further argues that Sasagawa et al describes preferred embodiments employing potassium hydroxide in combination with potassium carbonate, for example. However, the preferred embodiment does not exclude the use of potassium hydroxide alone but illustrates a more desired embodiment within the scope of the Sasagawa et al invention. Furthermore, claim 1 in Sasagawa et al provides further evidence that the invention therein includes an embodiment therein where potassium hydroxide is used alone (i.e. "wherein said potassium salt comprises...at least one member selected from the group consisting of potassium carbonate, dipotassium hydrogenphosphate and potassium hydroxide...").

Applicant further argues that claims 38-54 are allowable since same are directed to subject matter substantially identical to previous claims indicated as allowable. However, it should be noted that this claimed subject matter is no longer considered to be allowable in view of the rejection of claims 38-54 under JP 11-9190 which was not yet appreciated for its pertinence to the instant claims as of the Office Action mailed 3/10/05.

All other arguments have been addressed in view of the rejections as set forth above.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Weier whose telephone number is 571-272-1409. The examiner can normally be reached on Monday-Thursday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Anthony Weier
Primary Examiner
Art Unit 1761

Anthony Weier
May 4, 2006